

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Seong Min Seo, Young Suk Chung, Jon Sik Paek, Jae Hun Ku, Jae Hak Yee  
 Assignee: Amkor Technology, Inc.  
 Title: Semiconductor Package Including Stacked Chips  
 Serial No.: 09/816,599 Filing Date: March 23, 2001  
 Examiner: Not Yet Assigned Group Art Unit: 2811  
 Docket No.: AB-1111 US

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San Jose, California  
August 29, 2001

OCT 26 2001

COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

PETITIONS OFFICE

PETITION FOR FILING BY OTHER THAN ALL INVENTORS  
 UNDER 37 C.F.R. 1.47(A)

Dear Sir:

Applicants Seong Min Seo, Young Suk Chung, and Jong Sik Paek hereby petition the Commissioner to accept the filing of the above identified U.S. patent application by other than all of the inventors. Their co-inventors, Jae Hun Ku and Jae Hak Yee, refuse to participate in the application.

The last known residence addresses for Messrs. Ku and Yee are:

Jae Hun Ku  
 101-201 Yongma Dongah Apt.  
 Myeonmok-dong, Jungang-gu  
 Seoul, Republic of Korea

Jae Hak Yee  
 23 St. Thomas Walk  
 #07-03 S. K Mansion  
 Singapore 238108

The facts concerning the status of Messrs. Ku and Yee and the efforts made to obtain their participation in the application are set forth in the accompanying declaration of the undersigned, James E. Parsons. Briefly, Mr. Yee left the employment of Anam Semiconductor Inc., which was later acquired by Amkor Technology, Inc., ("Amkor") and to Amkor's knowledge joined a competitor company, ST Assembly Test Service, Ltd. ("STATS") of Singapore. Mr. Ku subsequently resigned from Amkor and also is believed to have joined STATS. Amkor has contacted STATS' attorneys concerning this application and

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795627 v1

-1-

Serial No. 09/816,599

have requested the participation of Messrs. Ku and Yee in the present application, but have not obtained any cooperation from them.

The names and address of STATS' attorneys, with whom Amkor has been instructed to deal concerning employees of STATS, are:

Davinder Singh, Esq. and Jupiter Kong, Esq.  
Drew & Napier  
#17-00 Ocean Towers  
Singapore 048620

In a larger context, the present application is just one of several where Messrs. Ku and Yee and other former employee/inventors of Anam or Amkor have refused to participate in Amkor's patent applications since joining STATS. Amkor and STATS compete in the same semiconductor industry sector, namely, semiconductor packaging, assembly, and testing. Moreover, Amkor and STATS have legal disputes in both the U.S. and Singapore. This situation makes it unlikely that Messrs. Ku or Yee will participate in these patent applications absent a change in the relations of Amkor and STATS.

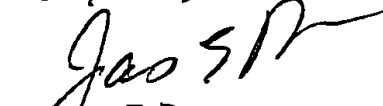
In view of the diligent, albeit unsuccessful, efforts to obtain Messrs. Ku and Yee's participation in the present application, co-inventors Seong Min Seo, Young Suk Chung, and Jong Sik Paek respectfully request the grant of this petition.

The petition fee required by 37 C.F.R. 1.17(i) may be charged to Deposit Account 19-2386. A duplicate copy of this petition is being submitted herewith.

EXPRESS MAIL LABEL NO.

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Respectfully submitted,

  
James E. Parsons  
Attorney for Applicants  
Reg. No. 34,691

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Seong Min Seo, Young Suk Chung, Jon Sik Paek, Jae Hun Ku, Jae Hak Yee  
 Assignee: Amkor Technology, Inc.  
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COMMISSIONER FOR PATENTS  
 Washington, D.C. 20231

PETITIONS OFFICE

**DECLARATION OF JAMES E. PARSONS IN SUPPORT OF PETITION  
 FOR FILING BY OTHER THAN ALL INVENTORS (37 C.F.R. 1.47(A))**

I, James E. Parsons, declare as follows.

1. I am a registered U.S. patent attorney (no. 34,691) and an attorney of record on this application. My office is at Skjerven Morrill MacPherson LLP, 25 Metro Drive, Suite 700, San Jose, California, 95110 (phone (408) 453-9200).

2. Joint inventors Jae Hun Ku and Jae Hak Yee are and have been unwilling to participate in the present application. I have made efforts to obtain their participation, as I will discuss further below, but these efforts have not been successful.

3. I was informed that Messrs. Ku and Yee were formerly employed by Anam Semiconductor Inc. ("Anam"). Assets of Anam, including the present invention, were acquired by assignee Amkor Technology, Inc. ("Amkor") on May 1, 2000. Mr. Yee resigned from Anam on December 28, 1999 and Mr. Ku resigned from Amkor Technology Korea, Inc. on October 25, 2000.

4. I am informed and believe that Messrs. Ku and Yee joined a competitor to Amkor, namely, ST Assembly Test Services, Inc. of Singapore ("STATS"). Amkor and STATS compete in the same semiconductor industry sector, namely, semiconductor

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packaging, assembly, and testing. In addition to being business competitors, Amkor and STATS have legal disputes between them in both the U.S. and Singapore.

5. According to communications from STATS' attorneys, Amkor and its attorneys are not to directly communicate with former employee/inventors of Anam or Amkor who are now in the employ of STATS. Rather, all communications with the former employee/inventors are to go through STATS' attorneys, i.e., the Drew & Napier law firm of Singapore. The relevant attorneys are:

Davinder Singh, Esq. and Jupiter Kong, Esq.  
Drew & Napier  
20 Raffles Place  
#17-00 Ocean Towers  
Singapore 048620

6. As mentioned above, I have made efforts, all unsuccessful, at obtaining the participation of Messrs. Ku and Yee in the present application. In particular, I engaged Axel Chan of the law firm of John, Tan & Chan of Singapore to contact Messrs. Ku and Yee through the Drew & Napier firm. At my instruction, Mr. Chan sent a letter to Drew & Napier on April 16, 2001 requesting that Messrs. Ku and Yee review the application and sign the inventor declaration for this application. A copy of Mr. Chan's letter is attached hereto as Exhibit A. A reminder letter was sent by Mr. Chan on May 18, 2001. Drew & Napier wrote back on May 22, 2001 and informed that they would revert back with their clients decision on whether to participate. A copy of the letter from Drew & Napier is attached as Exhibit B. To date, no response has been received. The failure of Messrs. Ku or Yee or STATS attorneys to contact Mr. Chan or Amkor subsequent to May 18, 2001 constitutes an admission that Mr. Ku and Mr. Yee are employed by STATS, and also constitutes a refusal on their parts to participate in the present application.

7. I also am prosecuting three other U.S. patent applications for Amkor, each of which also has an outstanding Notice to File Missing Parts. In each case, the applications were filed without inventor declarations from one or more former employee/inventors of Anam or Amkor who now work for STATS. Mr. Ku is an inventor on three of the four applications, and Mr. Yee is an inventor on two of the four applications. In each of those three cases, Mr. Chan has contacted STATS' counsel to obtain participation of the missing inventors. In no case has Messrs. Ku or Yee or any of the other former employee/inventors come forward to participate. Accordingly, it appears that STATS, Messrs. Ku and Yee, and the other former employee/inventors of Anam or Amkor have made a decision not to

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cooperate in the present application or the three other applications mentioned above, and I expect such non-cooperation will continue absent a change in the relations of Amkor and STATS.

8. I further declare that all statements made herein of my own personal knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above referenced application or any patent issuing therefrom.

Date:

8/29/01  
James E. Parsons

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Oct-26-2001 04:17pm From-SKJERVEN, MORRILL, MACPHERSON

4088841007

T-325 P.011/017 F-938

A

# John, Tan & Chan

(formerly John & Tan)

Advocates & Solicitors

Notaries Public

Commissioners for Oaths

Tan Jing Poi 陳國培律師  
Daniel John 丹尼爾·約翰律師  
Axel Chan 陳國培律師

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REBECCA LEONG

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Your Ref: DS/JKC/sm/198092  
Our Ref: AC/aa(lt)/01060395  
Date: 16 April 2001

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OCT 26 2001

PETITIONS OFFICE

M/s Drew & Napier  
20 Raffles Place  
#17-00 Ocean Towers  
Singapore 048620

By fax (533 0694) & by mail

Attn: Davinder Singh, Esq/Jupiter Kong, Esq

Dear Sirs,

Re: U.S. Patent Application entitled: "Semiconductor Package Including Stacked Chips"

Inventors: Seong Min Seo, Young Suk Chung, Jong Sik Paek, Jae Hun Ku, Jae Hak Yee

Serial No.: 09/816, 599  
Filing Date: March 23, 2001

Re: U.S. Patent Application entitled: "Semiconductor Package"

Inventors: Seong Min Seo, Young Suk Chung, Jong Sik Paek, Jae Hun Ku, Jae Hak Yee

Serial No.: 09/816, 852  
Filing Date: March 23, 2001

We have been instructed to seek the assistance of Messrs. Jae Hun Ku and Jae Hak Yee in the above US Parent Applications filed by our clients in the US.

Please confirm whether Messrs. Jae Hun Ku and Jae Hak Yee, two of the named inventors of the above applications, are willing to review the applications and sign the respective Declarations for Patent Application and Power of Attorney, and Assignments.

If they will not cooperate, or if STATS will not allow them to cooperate, please let us know immediately.

Yours faithfully,  
for John, Tan & Chan

Axel Chan

cc clients

Oct-26-2001 04:17pm From-SKJERVEN, MORRILL, MACPHERSON

4088941007

T-325 P.013/017 F-838

B

Tan Jing Poi 陈西峰 律师  
Daniel John 丹尼理 - 陈柏荣 律师  
Axel Chan 陈

Lim Fung Pean 林方成 律师  
Damita Nathan 纳美坦 律师  
Rebecca Leong 梁美仪 律师

# John, Tan & Chan

(formerly John & Tan)  
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Notaries Public  
Commissioners for Oaths

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Your Ref: DS/JKC/sm/198092  
Our Ref: AC/aa(lt)/01060395  
Date: 18 May 2001

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20 Raffles Place  
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Singapore 048620

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PETITIONS OFFICE

By fax (533 0694) & by post

Attn : Davinder Singh, Esq/Jupiter Kong, Esq

Dear Sirs,

## ST ASSEMBLY AND TEST SERVICES LTD US PATENT APPLICATIONS - REVIEW/SIGNATURES OF INVENTORS

We refer to our letter dated 16 April 2001 in relation to which we have not heard from you.

Please let us know urgently if Messrs. Jae Hun Ku and Jae Hak Yee will assist our clients in their US Patent Applications by reviewing and signing them.

Yours faithfully,  
for John, Tan & Chan



Axel Chan

cc clients

Oct-26-2001 04:18pm From-SKJERVEN, MORRILL, MACPHERSON

4088841007

T-325 P.015/017 F-838

C

# DREW & NAPIER LLC

Advocates & Solicitors • Trademark & Patent Agents

22 May 2001

BY FAX &amp; POST

Fax no. 538 1882

No of pages. 1

John, Tan & Chan  
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FOR: Mr Alex Chan

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Please quote our ref. in reply

OUR REF DS/JKC/198092/dhm

YOUR REF AC/32(1)/11060395

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you should not copy it or use it for any purposes, nor disclose its contents to any other person.*

Dear sir,

## ST ASSEMBLY AND TEST SERVICES LTD US PATENT APPLICATIONS - REVIEW / SIGNATURES OF INVENTORS

We refer to your letter of 18 May 2001.

We have forwarded your letter to our clients and will keep you informed once we receive a response from them.

Yours faithfully



DREW &amp; NAPIER LLC

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Senior Consultant  
J. Gnanapavan  
Senior Counsel

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Tan Hui Yee  
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Yip Fui Chin  
Vivian Tan  
Joni Thio  
Liam Kim  
Liam Kim  
Wendell Wong  
Garry Low  
Ng Seng Lee  
Nicholas Tan  
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Associate  
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William Ang  
Harinder Kaur  
Vijayalakshmi  
Paul Tan  
Gee Wai  
Aashish Vargis

Lim Wei Hui  
Rama Shankar Thiruv  
Adeline Wip  
Lion Kian Wip  
Kevin Liew  
Wong Tan  
Linda Yuen  
Christine Chua  
Teresa Lim  
Adrian K. Seng  
Liam Seng  
Linda Li  
Lim Kuan  
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John K. Malone (NY, USA)  
International Lawyers  
Charles H. (New York)  
Charles Goh (Singapore)  
Joseph Chan (Malaysia)

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UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
09/816,599	03/23/2001	Seong Min Seo	AB-1111 US

CONFIRMATION NO. 6166

FORMALITIES LETTER



\*0000000006200155\*

James E. Parsons  
SKJERVEN MORRILL MacPHERSON LLP  
25 Metro Drive, Suite 700  
San Jose, CA 95110-1349

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OCT 26 2001

PETITIONS OFFICE

Date Mailed: 06/19/2001

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

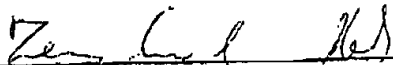
FILED UNDER 37 CFR 1.53(b)

*Filing Date Granted*

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The signature of the following inventor(s) is missing from the oath or declaration:  
*Jae Hun Ku and Jae Hak Yee*
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.
- The balance due by applicant is \$ 130.

*A copy of this notice **MUST** be returned with the reply.*

  
\_\_\_\_\_  
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Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE

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